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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Re-APR 1 - 1996

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSAN K. JONGEWAARD
and ALAN G. MILLER

Appeal No. 94-0387
Application 07/719,144¹

ON BRIEF

Before JOHN SMITH, PAK and WARREN, *Administrative Patent Judges*.
WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 14, 15 and 17 through 21, which are all of the claims remaining in the application. Claim 14 is illustrative:

14. A donor suitable for thermal printing comprising a backing, said backing comprising a polymeric material or a fibrous material, said backing having on one major surface thereof a layer of image-forming material, said image-forming material being transferable to a receptor upon application of heat, and said backing having on the opposite major surface

¹ Application for patent filed June 21, 1991. According to applicants, the Application is a Division of Application 07/326,300 filed March 21, 1989.

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thereof an anti-stick layer comprising at least one polymeric material having a non-cyclic, substantially completely saturated hydrocarbon backbone, said backbone having substantially only hydrogen atoms and methyl groups attached to randomly positioned carbon atoms thereon, with no more than one methyl group attached to any one backbone carbon atom.

The claims on appeal, as represented by claim 14,² are drawn to a donor for thermal printing which includes sheet stock having at least three layers wherein a backing layer has an image-forming layer on one side thereof and an anti-stick layer on the other side thereof. The anti-stick layer is characterized as comprising at least one polymeric material which has a substantially completely saturated non-cyclic hydrocarbon backbone that is substituted by substantially only methyl groups on randomly positioned carbon atoms, with no more than one methyl group attached to any one backbone carbon atom.

The references relied on by the Examiner are:

Mizobuchi	4,778,729	Oct. 18, 1988
Sarkar et al. (Sarkar)	5,001,012	Mar. 19, 1991

Claims 14, 15 and 17 through 21 on appeal stand rejected under 35 U.S.C. § 103 as being unpatentable over Sarkar in view of Mizobuchi. Upon careful review of the record presented on appeal, we find that we cannot sustain this rejection.

² We will not discuss here the particulars of the remaining claims on appeal as Appellants have stipulated that all of the claims on appeal stand or fall together (Brief, page 8).

Rather than reiterate the respective positions advanced by the examiner and the appellants with respect to the grounds of rejection, we refer to the answer and to the brief for a complete exposition thereof.

Opinion

We find ourselves in agreement with appellants that the examiner has failed to carry his burden of establishing a *prima facie* case of obviousness over the references relied on. This burden may be satisfied by showing some objective teachings or suggestions in the prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to combine the relevant teachings of the references in the proposed manner to arrive at the claimed invention without recourse to the teachings in applicants' disclosure. See generally *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); *In re Fine*, 837 F.2d 1071, 1074-1076, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988) and cases cited therein; *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

We think it is apparent from the disclosure in the specification (e.g., pages 5 and 8 through 10) and appellants' summary of the invention in the brief (pages 4 to 6) that the claims on appeal must be interpreted as requiring that the polymeric

material comprising the anti-stick layer must have methyl groups substituted on randomly positioned carbon atoms. *In re Zletz*, 893 F.2d 319, 320-22, 13 USPQ2d 1320, 1321-22 (Fed. Cir. 1989); *In re Johnson*, 558 F.2d 1008, 1015-16, 194 USPQ 187, 193-94 (CCPA 1977); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Thus, we are of the view that donors wherein the anti-stick layer comprises polymers which are not methyl substituted, such as paraffin waxes and polyethylene waxes, as well as polymers which have uniform methyl substitution along the backbone, such as any of the forms of polypropylene *per se*, would not be included within the claimed subject matter.

The examiner in his answer has relied on Mizobuchi as teaching that the "anti-stick layer can contain waxes such as polyethylene and paraffin waxes" in contending that one of ordinary skill in the art would "use these waxes in combination with the specifically claimed silicone containing resin of ... Sarkar" (page 4; see also page 6). However, since the claims clearly exclude both of the waxes specifically disclosed in Mizobuchi, the combination of these teachings with those of Sarkar would not result in the claimed invention, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988), and the examiner has provided no rationale why these specifically disclosed waxes would have motivated one of ordinary skill in the art to use the methyl

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substituted polymeric materials required by the claims on appeal. Thus, when considered on this record, the combination of references would have failed to reasonably suggest the claimed invention to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 424-26, 208 USPQ 871, 881-82 (CCPA 1981), and the concurring opinion of Chief Judge Nies in *Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1446.

We observe that claim 15 does not comply with 35 U.S.C. § 112, fourth paragraph, and, accordingly, enter the following new ground of rejection under the provisions of 37 CFR § 1.196(b).

Claim 15 is rejected under 35 U.S.C. § 112, fourth paragraph, as failing to further limit the subject matter claimed in claim 14 on which it is dependent. Inasmuch as claim 14 requires that the backing layer have a layer of image-forming material on one major surface thereof and an anti-stick layer on the opposite major surface thereof, the backing layer is clearly required to be "disposed" between said layers on the major surfaces, which is, of course, the same requirement as in claim 15.

In summary, we have reversed the rejection of claims 14, 15 and 17 through 21 under 35 U.S.C. § 103 and have set forth a new ground of rejection of appealed claim 15 under the provisions of 37 CFR § 1.196(b).

The examiner's decision is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

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